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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,033	09/28/2001	Joshua R. Smith	103140-0012U1	7207
24267 7590 02/04/2009 CESARI AND MCKENNA, LLP 88 BLACK FALCON AVENUE BOSTON, MA 02210				
EXAMINER PLUCINSKI, JAMESUE A				
ART UNIT		PAPER NUMBER		
3629				
MAIL DATE		DELIVERY MODE		
02/04/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/966,033

Applicant(s)

SMITH ET AL.

Examiner

JAMISUE A. PLUCINSKI

Art Unit

3629

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4, 7, 9-11, 13, 18-26, 28-30, 32 and 34-47 is/are pending in the application.
- 4a) Of the above claim(s) 3, 7, 9-11, 13, 20, 25, 26, 32 and 34-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 4, 21-24 and 28-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 21-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. With respect to Claims 21-24: the phrase "a method... embodied in a computer readable medium including the steps of:" is indefinite. The applicant has amended the claims to recite this limitation; however now it is unclear what statutory class the claims fall into, a method or an apparatus (e.g. medium). Furthermore it is unclear to the examiner how a method can be embodied in a medium. A method is series of steps, which are to be performed, therefore how can actions be embodied in a medium. In order for the claim to be a proper computer readable claim, the preamble would have to state computer executable instructions were embodied on the medium, and recite that the instructions cause the computer to perform the method steps.
4. With respect to Claims 21 and 22: the applicant has attempted to correct a 101 rejection by adding into the body of the claims, steps being done "on said users personal webpage", when the steps are done by the server, or by the sender, therefore causing it to be unclear how these steps can be performed on the user's personal webpage. For example, Claim 21 states "receiving mail piece delivery status information displayed on a personal web page from one or more mail piece delivery companies". This information is received into the computer system, and then

linked and displayed on the personal webpage, therefore causing it to be unclear what is actually being done on the webpage, and if it is accessed by the sender, and the delivery companies, then it is really a user's personal webpage?

5. It should be noted, that due to the fact that the 112 issues which have now arisen due to the amendment, the 101 rejection has been dropped. As stated above, it appears the claims are attempting to switch statutory classes to a computer readable medium, therefore if properly claimed would be a statutory class. Furthermore, the newly added claim limitations, it is unclear really what steps are being done on the webpage. It should be noted, that if the applicant were to stay with the claims being a method, and delete the previous phrases, the 101 rejection would still exist, due to the fact that Bilski states that "insignificant extra solution activity" being done on a particular machine, does not render the claims to be statutory. The term "providing" is given the general meaning of "making available", therefore unless something is done on the webpage, more than just displayed, then displaying information on a webpage becomes extra solution activity. It should also be noted that when information, that is displayed on a webpage, is received, it does not necessarily require the use of a particular machine, due to the fact that a user can simply view the screen and write the information down on a piece of paper, and the display then becomes extra solution. The examiner suggests adding into the claim, where the information is received, positively recite the particular machine it is received in, such as a systems server, to more clearly define where the information is being received and where it is processed, this will in turn correct the 112 issues as well as any 101 rejections which may arise in the future.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 4, 21-24 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bilibin et al. (US 2005/0197892) in view of Guidice et al. (6,463,420).

8. With respect to Claims 2, 4, 20-323 and 28-30: Bilibin discloses the use of a method comprising the steps:

- a. Associating respective users with user identifiers (Paragraph 162, registering and creating user ID and passwords);
- b. Associating with the respective users mail pieces directed by others, different carriers, to respective users sent to others by the respective users (Figures 56 and 57 with corresponding detailed description, the examiner notes who the mail piece is sent to does not patentably distinguish itself from the prior art, the tracking would be processed the same regardless of the recipient, therefore considered to be non-functional descriptive material);
- c. Linking to the user identifiers to which the mail pieces are associated mail piece delivery status information relating to the respective mail pieces (Figure 50, Reference numerals 441-442 with corresponding detailed description);
- d. Receiving information concerning the contents of the respective mail pieces from the senders of the respective mail pieces and linking to the delivery status information an

attachment consisting of the information concerning the contents of the respective mail pieces (Figures 51-54 with corresponding detailed description). However, the specific type of information (i.e. text information, graphics audio file) is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The providing and display steps would be performed the same regardless of the noises or pictures presented. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

e. Providing a graphical interface configured for entering user identifiers and providing access (Paragraph 147 and Figure 54 Reference numeral 1258 with corresponding detailed description) to:

- i. Producing on the users personal webpage a respective listing of the delivery status information directed to the respective users (See Figure 76, Bilibin discloses a shipping log of inbound and outbound packages for the user, therefore the examiner considers this a users personal webpage);
- ii. Provide the mail piece delivery status information that is linked to the user identifiers that are associated with the respective users, and
- iii. Provide to the respective users the associated information concerning the contents of the respective mail pieces (See Figures 71-72 with corresponding detailed description).

- iv. Including links to the respective messages in the listing of the delivery status information, which allows a user to perform sending and receiving a message (Figure 72 with corresponding detailed description, which allows a user to receive a message when delivered).
 - f. Bilibin discloses that everything that is done, is done through a webpage, where a user signs in and can view transaction history as well as shipping logs, the examiner considers this to be a personal webpage, due to the fact that a user has to sign in to access all their information, which is stored in the server (See Figure 76 with corresponding detailed description).
- 9. Bilibin discloses linking the user identifiers to the mail pieces, however fails to teach linking the mail piece delivery status with the user identifier. Guidice teaches the system identifying if the submitted orders that can be tracked according to the user ID (Column 6, lines 45-60). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to combine the associated steps of Guidice with the multi-carrier tracking of Bilibin. The claimed invention is merely a combination of old elements and in the combination each element merely would have performed the same function as it did separately and one of ordinary skill in the art would have recognized that the results of the combination were predictable (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).
- 10. Bilibin also fails to teach the user accessing the above information by entering user identifiers. Guidice teaches the user entering the ID and password in order to be able to select the order for which the user wishes to track (Column 6, line 45). It would have been obvious to

one having ordinary skill in the art at the time the invention was made to combine the accessing steps of Guidice with the multi-carrier tracking of Bilibin. The claimed invention is merely a combination of old elements and in the combination each element merely would have performed the same function as it did separately and one of ordinary skill in the art would have recognized that the results of the combination were predictable (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

11. With respect to Claims 24: Bilibin discloses the use of one or more messages being provided by the sender associated with the mail piece (See Figure 51 with corresponding detailed description)

Response to Arguments

12. Applicant's arguments filed 11/21/08 have been fully considered but they are not persuasive.

13. The applicant is arguing the rejection based on the personal webpage. The examiner has revised the rejection above to cover the newly added claim limitations of the personal webpage. Bilibin has a feature, shown in Figure 76, where the user has a personalized interface. A user signs into the system, and the personal information, such as preferences is retained, as well as showering the users shipping log of inbound and outbound packages. Therefore the examiner considers this to be a form of a user personal webpage, due to the face that it shows only the particular registered user information, and hence personalized to whom ever is signed in.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMISUE A. PLUCINSKI whose telephone number is (571)272-6811. The examiner can normally be reached on M-F (8:30 - 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamisue A. Plucinski/
Primary Examiner, Art Unit 3629